

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Born in the USA LLC

Serial No. 87867549

Geoffrey M. Dureska of Dunlap Bennett & Ludwig, PLLC,
for Born in the USA LLC.

Robert Guliano, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

Before Lykos, Lynch and Coggins
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Born in the USA LLC (“Applicant”) seeks to register the proposed mark BORN IN THE USA in standard characters for “bottoms as clothing; footwear; headwear; tops as clothing” in International Class 25.¹ Applicant submitted the following specimens of use during prosecution:

¹ Application Serial No. 87867549 was filed April 8, 2018, based on an allegation of intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).



The Examining Attorney refused registration under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-52 and 1127, on the ground that the proposed mark fails to function as a trademark because it is a widely used informational message, and under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the prior registered mark BORN & BRED IN THE USA in standard characters for a variety of clothing goods.² When the Examining Attorney made the refusals final, Applicant requested reconsideration and appealed. The Examining Attorney maintained the refusals, the appeal resumed, and the case has been fully briefed.

Applicant amended the application to proceed under Section 1(a), 15 U.S.C. § 1051(a), when it filed an amendment to allege use on July 5, 2018.

² Registration No. 5001008 issued on July 19, 2016.

II. Failure to Function

A. Legal Background

“The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark....” *In re The Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960). Section 45 of the Trademark Act defines a “trademark” as “any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” *See also In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached”).

We must assess whether Applicant’s proposed mark, BORN IN THE USA, functions as a mark based on whether the relevant public, i.e. purchasers or potential purchasers of Applicant’s clothing goods, would perceive BORN IN THE USA as identifying Applicant’s goods and their source or origin. *See e.g. In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, *1-2 (TTAB 2019) (“The key question is whether the asserted mark would be perceived as a source indicator for Applicant’s [goods or] services.”); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“[T]he critical inquiry is whether the asserted mark would be perceived as a source indicator.”); *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992). In this case, because there are no limitations to the channels of trade or classes of consumers of the clothing identified in the application, the relevant consuming public

comprises all potential purchasers of bottoms as clothing, footwear, headwear, and tops as clothing. *See CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).

Matter that is merely informational is not registrable as a mark. *See In re AOP LLC*, 107 USPQ2d 1644, 1655 (TTAB 2013) (refusal of AOP affirmed where the specimens “present the term in an informational manner to inform consumers about a certification process rather than as a source identifier”); *In re T.S. Designs, Inc.*, 95 USPQ2d 1669, 1671-72 (TTAB 2010) (holding CLOTHING FACTS merely informational and not a source identifier of clothing based on likely consumer perception). If consumers would view a proposed mark as simply conveying information, the proposed mark does not function as an indicator of source and cannot be registered. For this analysis, in addition to an applicant’s specimens, we also consider other evidence in the record. *See In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1230 (TTAB 2010) (affirming informational refusal of ONCE A MARINE, ALWAYS A MARINE where third-party evidence showed widespread use of the phrase and use on “applicant’s specimens as well as its other materials would likely reinforce the perception” of the proposed mark as informational).

B. Evidence and Analysis

The Examining Attorney argues that the proposed mark is a commonplace message or expression that is widely used by a variety of sources, including in the context of clothing goods such as Applicant’s, to convey an informational patriotic

sentiment of origination in the United States.³ Examples of evidence reflecting use of the phrase to inform that goods are made in the United States (emphasis added) include:

- An article in Reviewed titled “**Born in the USA: American-Made Appliances**” states “it’s a great time to celebrate the **American worker** with a rundown of the top **US-made** home appliances.”⁴
- A Sol Angeles **Born in the USA** T-Shirt offered on the Nordstrom Rack website is promoted with, “Celebrate the Fourth like the freedom-loving patriot you are in this soft, cotton **USA-made** shirt.”⁵
- The “**Born in the USA Knotty Band**” product webpage states “Show your patriotic spirit with our headband that is an **American Made** product bearing our symbol, our treasured flag.”⁶
- The webpage of the University of Connecticut’s Sports Management Program features a “snapshot” about “Origin BJJ – **American Made Gi**,” with the tagline “Weave it. Stitch it. Trim it. **Born in the USA.**” The company emphasizes that its Brazilian jiu-jitsu competition gear (known as “gi”) is

³ 10 TTABVUE 9 (Examining Attorney’s Brief).

⁴ Citations to the application record are to the TSDR downloaded .pdf format. July 25, 2018 Office Action at 8-9 (reviewed.com).

⁵ November 28, 2018 Office Action at 36 (nordstromrack.com). The record includes two Office Actions dated November 28, 2018, and we cite to the TSDR downloaded .pdf format of the second in the reverse-chronological list. This Office Action includes all the evidence in the other Office Action of the same date, as well as evidence duplicative of the evidence in the July 25, 2018 Office Action.

⁶ November 28, 2018 Office Action at 45 (tawgear.com).

American-made.⁷

- The website of Klein Tools includes the page “**Born in the USA: An Inside Look at Klein Plastics,**” referring to the Rockford, MI plant as “one of Klein’s seven **American manufacturing** plants.”⁸
- An article on the BMW Group website is titled “**Born in the USA. Rolls-Royce Overseas.**” It describes Rolls-Royce’s popularity in the U.S. after World War I and the company’s decision to build a second plant in the U.S. to avoid high import duties and transportation costs, noting “A total of 2,994 Rolls-Royce Silver Ghost and Phantom I models were **made in the USA** over a period of twelve years.”⁹
- An article on the Albany Times Union website is titled “**Born in the USA: 2012 Chevy Sonic,**” and states that the vehicle “holds the distinction of being the only subcompact **made in the U.S.**”¹⁰
- The Perry Ellis website (excerpts below) touts “Perry Ellis Denim: **Born in the USA.**” In addition to describing jeans as “an American icon, a rugged stitch that has helped weave a nation,” the text states that “Perry Ellis jeans are an **American product – from design stages to manufacturing.**”¹¹

⁷ November 28, 2018 Office Action at 46 (sport.education.uconn.edu).

⁸ November 28, 2018 Office Action at 47 (kleintools.com).

⁹ November 28, 2018 Office Action at 48 (bmwgroup-classic-heart.com).

¹⁰ November 28, 2018 Office Action at 49-50 (timesunion.com).

¹¹ November 28, 2018 Office Action at 52-53 (perryellis.com).

THE DESIGN STUDIO

PERRY ELLIS DENIM: BORN IN THE USA

DENIM FOR THE DARING

DEC 9, 2013



America the beautiful

Perry Ellis jeans are an American product - from design stages to manufacturing. Designers from New York City dream up the pant. American cotton is ring spun, dyed and finished in the town of Greensboro, North Carolina. The fabric is then shipped to El Paso, Texas, where it gets cut, assembled and detailed to make every pair a work of American ingenuity. That's a beautiful thing.

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- The KanJam website (excerpts below) bears the taglines “**Born in the USA**” and “Proud to be an **American-Made** Product,” noting that its sporting goods and games are not made in China like most others, and instead are examples of “**American-made** manufacturing.”¹³

¹² *Id.*

¹³ November 28, 2018 Office Action at 55 (kanjam.com).



PROUD TO BE AN AMERICAN-MADE PRODUCT

KanJam is a proven example of how American-made manufacturing can be successful, and compete with overseas competition.

When we first started our company in 2006 it was presumed that our KanJam game was manufactured in China. After all, wasn't every sporting good and game item made there? People were surprised to hear that we could manufacture a product made from plastic here in the USA and make it better, and less expensive. KanJam is proof

It seems like it was just a few short years ago that we were assembling KanJam games late nights in the basement. Today KanJam has a robust product line including: Kan Jam Mini, Kan Jam Splash, Kan Jam Gliders, various Glow-in-the-Dark products, Custom Flying Discs and accessories. KanJam products are also sold in over 12,000 retail locations across the USA, in 23 countries in Europe, across Canada, Australia and New Zealand. KanJam is also growing in schools as part of physical education curriculums across the USA. Today, over 7,000 schools use Kan Jam and counting!

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- The ML Kishigo website (excerpt below) states that “[f]or the past 40 years, ML Kishigo has been **making garments in the USA.**” Next to “**Made in the USA,**” the text states, “[o]ur designs are **born in the USA** and will stay in the USA.”¹⁵

¹⁴ *Id.*

¹⁵ November 28, 2018 Office Action at 56.

Products Made in the USA High Visibility FAQ's About Us Quote

For the past 40 years, ML Kishigo has been making garments in the USA. We are proud that our innovative and progressive designs are all created here in the USA by our talented design team. With invaluable feedback from the hardworking men and women from around the country, we've been able to create the best in class in both design, durability and functionality for the workers who wear our high visibility apparel daily on the job site. Each and every one of us at ML Kishigo commits to providing you with quality products that you can wear every day without fail.

Made in the USA

Our designs are born in the USA and will stay in the USA.

Our custom vests and FR products are produced in our Santa Ana, California factory. And we take our same "no compromises" and dedication to quality and detail globally as we source our ML Kishigo Catalog stock line of products. Same fabrics, same details, same quality assurance that you have come to demand and expect from a Company that's been providing high-quality, high-visibility apparel for decades.

From all of us here in Santa Ana, California,
we're proud to support hardworking Americans just like you.

(Custom and FR garments are Manufactured in the USA)

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- The Mountain website has an article about **U.S. production** of fly fishing gear with the headline “**Born in the USA. Time tested gear for fly-fishers.**” The article opens with, “Fly fishing isn’t bringing production back to the U.S. – in this industry, domestic manufacturing never fizzled.”¹⁷
- The Noelle Munoz website (described as “Business, Gift Ideas, Marketing”) blog (excerpt below) includes a post titled “**born in the usa**” featuring a

¹⁶ *Id.*

¹⁷ November 28, 2018 Office Action at 59 (mountainonline.com).

“**MADE IN THE USA**” logo and referring both to the author’s birth in the U.S. and her **affinity for American-made products**. The post states that “I want people to know I am not having my work made over seas [sic] or buying my materials from another country. I am making every attempt to support America with my business....”¹⁸

BUSINESS, GIFT IDEAS, MARKETING - FEBRUARY 1, 2011

born in the usa

I have a special American pride which is probably enhanced by the fact that I was born on the fourth of July, but that wouldn't matter if I wasn't born in the USA. Most of you reading were also "made in America".



My Mom who is always lookin' out shared this story with me; ABC news claims that if we each spent an extra \$3.33 on US made goods we would create an extra 10,000 US jobs! How awesome is that? Check out American made products. They are calling it "extreme make over for homeland improvement". This will be a story I follow.

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The evidence shows that BORN IN THE USA is a widely used informational message that goods originate from the United States. Other similar messages have been deemed informational and unregistrable. For example, the Board held that INVESTING IN AMERICAN JOBS for various services including retail stores failed to function as a mark because it “is like other statements that would ordinarily be used in business or industry, or by certain segments of the public generally, to convey support for American-made goods, and thus would not be recognized as indicating

¹⁸ November 28, 2018 Office Action at 69-70 (noellemunozjewelry.com).

¹⁹ *Id.* at 69.

source and are not registrable.” *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1152 (TTAB 2019). Similarly, the Board held that PROUDLY MADE IN USA for electric shavers and parts would be perceived not as a source indicator but instead as an informational slogan. *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987).

Applicant argues that its specimens “unequivocally demonstrate trademark use, namely use of the mark in on [sic] the inside collar of the Applicant’s goods and upon the product packaging.”²⁰ Given the nature of the wording and its widespread use in many contexts including in connection with clothing, Applicant’s manner of use of the proposed mark on the specimens does not negate its informational nature. “[T]he mere fact that [A]pplicant’s slogan appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark.” *Wal-Mart Stores*, 129 USPQ2d at 1152 (quoting *Safariland Hunting Corp.*, 24 USPQ2d at 1381); *see also D.C. One Wholesaler v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (“The fact that [an applicant] has sometimes displayed [the proposed mark] on hangtags and labels, in a non-ornamental manner that is conventional for the display of trademarks, does not require a different result [than the failure to function refusal].”) Regardless of Applicant’s placement of BORN IN THE USA on the packaging or on the inner neck of a shirt, the “widespread [informational and] ornamental use of the phrase by third parties,” and the “ubiquity of the phrase ... on apparel and other [goods] of many makers has given it a significance,” such that “it

²⁰ 8 TTABVUE 14 (Applicant’s Brief).

does not create the commercial impression of a source indicator, even when displayed on a hangtag or label.” *D.C. One Wholesaler*, 120 USPQ2d at 1716. In addition, on Applicant’s shirt specimen, its proposed mark appears with “Made in USA,” reinforcing the informational significance. The proposed mark also is placed in close proximity with other informational matter such as the size, fabric content, and laundering instructions.

The Examining Attorney also submitted additional evidence regarding BORN IN THE USA, much of which shows ornamental use of the wording emblazoned on the front of T-shirts and other clothing offered by a wide variety of retailers.²¹ Although this evidence does not directly refer to the informational message more overtly reflected in the other evidence detailed above, it does not detract from or undermine the informational refusal. Rather, as the Board in *D.C. One Wholesaler* noted in finding a mark informational, “[t]he widespread ornamental use of the phrase by third parties ‘is part of the environment in which the [proposed mark] is perceived by the public and . . . may influence how the [proposed mark] is perceived.’” *D.C. One Wholesaler*, 120 USPQ2d at 1716 (quoting *In re Hulting*, 107 USPQ2d 1175, 1178 (TTAB 2013) and *In re Tilcon Warren Inc.*, 221 USPQ 86, 88 (TTAB 1984)).

Applicant also submitted copies of the following seven third-party registrations that consist of or include the wording BORN IN THE USA for what Applicant concedes are “different and unrelated goods or services.”²² According to Applicant,

²¹ *E.g.*, July 25, 2018 Office Action at 10-20, 24-26; November 28, 2018 Office Action at 37-44.

²² 8 TTABVUE 14 (Applicant’s Brief). Applicant also introduced the TESS record for a cancelled registration, Registration No. 3734067. A cancelled registration is not evidence of

“there is little if any reason why BORN IN THE USA is capable of serving as a trademark for these applications and/or registrations but cannot serve as a trademark for the Applicant’s mark.”²³

- BORN IN THE USA for various oil-related tools and machinery, and other tools and equipment.²⁴
- BORN IN THE USA for live plants, flower bulbs and cut flowers.²⁵
- BORN IN THE USA for steel and steel fasteners.²⁶
- BORN IN THE USA (disclaimer of USA) for alcoholic beverages, except beer.²⁷



- BORN IN THE USA and  (same owner) for motorcycles and structural parts therefor.²⁸

- **BORN IN THE**
≡ USA for planetary gear heads.²⁹

any existing rights in the mark, *Action Temp. Servs. v. Labor Force*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989), and is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

²³ 8 TTABVUE 14 (Applicant’s Brief).

²⁴ 4 TTABVUE 21-24 (Reg. No. 4889777).

²⁵ 4 TTABVUE 25-28 (Reg. No. 4523365).

²⁶ 4 TTABVUE 29-33 (Reg. No. 5366320).

²⁷ 4 TTABVUE 41-45 (Reg. No. 5638764).

²⁸ 4 TTABVUE 13-14, 18-20 (Reg. Nos. 2863258 & 2861327).

²⁹ 4 TTABVUE 35-40 (Reg. No. 5415776).

We do not find the third-party registrations for other goods determinative. We “must assess each mark on the record of public perception submitted with the application.” In *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). The record in this case demonstrates the informational nature of the proposed mark and the “ubiquity of the phrase ... on apparel and other [goods] of many makers.” *D.C. One Wholesaler*, 120 USPQ2d at 1716. In addition, our record does not include the specimens of use for the third-party registrations, whereas Applicant’s shirt specimen of record places the proposed mark in close proximity to “Made in USA,” reinforcing the informational message of the proposed mark. Regardless, “[t]he PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016).

C. Conclusion

We find that Applicant’s proposed mark fails to function as a source indicator for the identified clothing goods.

Decision: We affirm the refusal to register Applicant’s proposed mark under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-52 and 1127, on the ground that it is a widely used informational message that fails to function as a trademark. Given our decision that Applicant’s proposed mark does not function as a mark, we need not reach the other ground of refusal based on alleged likelihood of confusion with a prior registered mark. *See Yazhong Inv. Ltd. v. Multi-Media Tech*

Ventures, Ltd., 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (citing *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013)).